

REMARKS

Applicant has reviewed the Notice of Non-Compliant Amendment under 37 CFR 1.121 mailed on February 24, 2005. This amendment with the following remarks is a substitute and a replacement for the bona fide attempt to reply to a final office action with the amendment filed on December 1, 2004 with an RCE. The present amendment includes the proper status identifier for each claim included. Specifically, the claim listing are made from the previous pending claims submitted on April 7, 2004. The Applicant's respectfully submit that the Notice of Non-Compliant Amendment should be withdrawn.

The Applicant has studied the Office Action dated July 11, 2004. Reexamination and reconsideration of this application is requested. By this response, claims 1-27, 33, 34, 37, 38, and 42 are pending in the application and are presented for the Examiner's review and consideration. It is submitted that the application is in condition for allowance. Reconsideration and allowance of the pending claims in view of the following remarks are respectfully requested. No new matter has been added. In the Office Action, the Examiner:

- (1-3) rejected claims 1-8, 15-27, 33, 34, 37, 38 and 42 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,249,809, to Bro ("Bro") in view of U.S. Patent No. 6,283,761, to Joao ("Joao");
- (4) rejected claims 9-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,249,809, to Bro ("Bro") in view of U.S. Patent No. 6,283,761, to Joao ("Joao") and further view of U.S. Pat. No. 5,935,060 to Iliff ("Iliff"); and
- (5) rejected claims 12-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bro and Joao as applied to claim 1 above, and further in view of Lade, Diane, "Cyber Docs people with a wide range of medical problem are finding support online from doctors and other patients themselves" ("Cyber Docs").

Overview of the Current Invention

Preferred Embodiments of the present invention provide an improved method and apparatus for a third party provider to act as an intermediary between patients and

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medical practitioners. As set forth in the specification, the attendant can, when the user requests, assist with the selection 2.7 of a medical practitioner and coordinate scheduling of an initial consultation with the selected medical practitioner, and thereafter transition the patient to a pre and post operative care system and method. (See e.g. ¶0069) The system representative inputs a record of the patient prospect's concerns and questions 5.3 and the system generates an updated patient profile form 101 indicating the patient's personal, demographic, medical and credit approval information as well as the patient's noted questions and concerns, which is then transmitted 5.4 to the medical practitioner at least 24 hours prior to the appointment. (Id.). The third party provider manages the process of obtaining financing from third party lenders for the medical procedure. For compensation of having a new patient referred to a medical practitioner, the medical practitioner pays a "finder's fee" (i.e. a portion of a fee charged to the patient by the medical provider) which is paid to the third party provider as consideration for bringing together the patient and the medical provider with financing through a third party lender.

In order to more particularly point out this feature of "finder's fee", the following language has been added to the independent claims, i.e., claims 1, 19, 23 33, 37 and 38 as follows:

[...]a portion of a fee charged by said medical practitioner for said medical procedure is paid by said medical practitioner to said third party provider in exchange for said third party bringing together said person and said medical provider for said medical procedure which is financed by said third party lender; and

Support for this amendment is found in the specification as originally filed in FIGs. 3A, 4, 5 and 6 along with paragraphs 0016, 0047, 0050, 0054, and 0059 in the published application US 2001/0021910.

(1-3) Claim Rejections under 35 U.S.C. § 103(a) Bro in view of Joao

As noted above, the Examiner rejected claims 1-8, 15-27, 33, 34, 37, 38 and 42 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,249,809, to Bro ("Bro") in view of U.S. Patent No. 6,283,761, to Joao ("Joao"). Independent claims 1, 19, 23,

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33, 37 and 38 have been amended to distinguish over Bro taken alone and/or in view of Joao. Specifically, the independent claims of the present invention have been clarified to permit a third party to act as an intermediary between a patient and a medical provider and to obtain financing from a third party lender for the medical procedure. As compensation for this intermediary role, the third party provider is compensated by the medical provider not the third party lender. This is unlike conventional financing systems where the medical practitioner pays a fee to the third party lender. For example, it is well known for a medical practitioner to pay a portion of a fee charged on a credit card back directly to a credit card company. In contrast, in the present invention, the medical provider pays a "finder's fee" i.e. a portion of his/her fee charged for the medical procedure as financed by a third party lender directly back to the third party provider. This is important because the third party, not the medical provider, manage and coordinate all financing in the present invention. The medical practitioner is referred a qualified, prospective patient with financing already pre-approved. As the Examiner correctly states on page 3 of the Office Action, Bro is silent on a third party provider acting as an intermediary and goes on to combine Bro with Joao.¹ The administration and maintenance of a financial account is taught by Joao at col. 37 lines 35-64. However, Joao is silent on the use of financing through third party lenders such as credit cards. The Examiner goes on to take official notice on page 4 of the Office Action *"that it is well known in the electronic commerce art to transmit and process said persons' financial/credit information to a lender for medical procedure financing."*² However, the accounts described for Joao are not part of a finder's fee arrangement where "a portion of a fee charged by said medical practitioner for said medical procedure is paid by said medical practitioner to said third party provider in exchange for said third party bringing together said person and said medical provider for said medical procedure which is financed by said third party lender." This type of financial arrangement for finding financing by an intermediary third party from a third party lender for a medical procedure is not suggested or taught by Bro taken alone and/or in view of Joao.

¹ Applicant makes no statement whether such combination is even proper.

² If however, the Examiner's statements are based on facts within the personal knowledge of the Examiner, the Applicant respectfully requests that the Examiner support these references by filing an affidavit as is allowed under MPEP §707 citing 37 CFR 1.104(d)(2).

Moreover, the Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness can not be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here the intent, purpose and function of Bro taken alone or in view of Joao is directed to "credit accounts." Even if we were to read into the "credit account" of third party lenders as the Examiner suggests under Official Notice, the service fee paid to the third party lenders is paid by the medical providers themselves. In contrast, the intent and purpose of the present invention is a third party acting as an intermediary where the medical providers pay the third party acting as an intermediary between the patient and the medical provider. Unlike the prior art systems, the third party acts as a broker who matches new patients with medical providers along with the requisite financing. The medical provider is not required to qualify the prospective patient for financing. This combination of Bro and Joao, as suggested by the Examiner, destroys the intent and purpose of an intermediary between the medical practitioner and patient whereby the medical practitioner provides a portion of his/her fee charged to the patient as a finder's fee to the third party for a procedure financed by a third party lender. Accordingly, the present invention is distinguishable over Bro taken alone or in view of Joao for this reason as well.

Continuing further, when there is no suggestion or teaching in the prior art for a third party intermediary, the suggestion cannot come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art references of Bro and Joao do not even suggest, teach nor mention a finder's fee i.e. a portion of a fee charged by said medical practitioner for said medical procedure is paid by said medical practitioner to said third party provider in exchange for said third party bringing together said person and said medical provider for said medical procedure which is financed by said third

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party lender.

In light of the foregoing, independent claims 1, 37, and 38 are respectfully submitted to be patentable over Bro in view of Joao. As claims 2-18 depend from amended claim 1 and necessarily include all the elements of their respective base claim, Applicant hereby respectfully submits that these claims are also patentable over the cited references at least for the same reasons and the Examiner's rejection should be withdrawn.

Applicant respectfully submits that the invention as claimed in amended claim 19 is not taught or suggested by Bro or Joao. Specifically, Bro discloses an automated and interactive system which is used to provide direct interaction between a physician and a patient, where the patient directly connects to a remote computer system to retrieve messages, information, or respond to inquiries provided by the physician. Joao discloses only that the patient can select and schedule their own appointments. There is no discussion or suggestion of a third party provider system which receives, processes, and provides information regarding patients to and from the patients and the medical practitioner and a medical practitioner system to receive, process, and provide information regarding said persons to and from said third party provider.

In light of the foregoing, independent claim 19 is respectfully submitted to be patentable over Bro in view of Joao. As claims 20-22 depend from amended claim 19, they necessarily include all the elements of their respective base claim. Applicant hereby respectfully submits that these claims are also patentable over the cited references at least for the same reasons.

Similarly, independent claims 23, 33, 37 and 38 have been amended to recite similar elements as recited in amended claim 1. Specifically, claims 23, 33, 37, and 38 each contain the element of a third party provider who schedules and coordinates medical consultations and said medical procedure between said persons and said medical practitioners. For the same reasons as set forth above, Applicant respectfully submits that claims 23, 33, 37, and 38 are patentable over Bro in view of Joao. Since claims 20-22 depend from amended claim 19, claims 24-27 and 42 depend from amended claim 23, and claim 34 depends from amended claim 33 and necessarily include all the

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elements of their respective base claims, Applicant hereby respectfully submits that these claims are also patentable over the cited references at least for the same reasons.

(4) Claim rejections under 35 U.S.C. § 103(a) Bro in view of Joao and Iliff

As noted above, the Examiner rejected claims 9-11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,249,809, to Bro ("Bro") in view of U.S. Patent No. 6,283,761, to Joao ("Joao") and further view of U.S. Pat. No. 5,935,060 to Iliff ("Iliff"). Independent claim 1 has been amended to distinguish over Bro taken alone and/or in view of Joao and/or in further view of Iliff.

Further as described in the section above entitled "35 U.S.C. § 103(a) Bro in view of Joao", independent claim 1 has been amended to recite a third party intermediary between the medical practitioner and patient. The Examiner goes on to combine Bro and Joao with Iliff.³ Iliff is silent on a "third party provider" acting as an intermediary.

In light of the foregoing, independent claim 1 is respectfully submitted to be patentable over Bro taken alone and/or in view of Joao and/or in further view of Iliff. As claims 9-11 depend from amended claim 1 they necessarily include all the elements of their respective base claim. Applicant hereby respectfully submits that these claims are also patentable over the cited references at least for the same reasons and the Examiner's rejection should be withdrawn.

(5) Claim rejections under 35 U.S.C. § 103(a) Bro in view of Joao, Iliff and Cyber Docs.

As noted above, the Examiner rejected claims 12-14 under 35 U.S.C. §103(a) as being unpatentable over Bro and Joao as applied to claim 1 above, and further in view of Lade, Diane, "Cyber Docs people with a wide range of medical problem are finding support online from doctors and other patients themselves" ("Cyber Docs"). Independent claim 1 has been amended to distinguish over Bro taken alone and/or in

view of Joao and/or in further view of Iliff.

As described in the section above entitled "35 U.S.C. § 103(a) Bro in view of Joao", independent claim 1 has been amended to recite a third party intermediary between the medical practitioner and patient. The Examiner goes on to combine Bro and Joao with Iliff and Cyber Doc.⁴ Cyber Doc is silent on a "third party provider" acting as an intermediary.

In light of the foregoing, independent claim 1 is respectfully submitted to be patentable over Bro taken alone and/or in view of Joao and/or in further view of Iliff and/or Cyber Docs. As claims 12-14 depend from amended claim 1, they necessarily include all the elements of their respective base claim. Applicant hereby respectfully submits that these claims are also patentable over the cited references at least for the same reasons and the Examiner's rejection should be withdrawn.

CONCLUSION

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicant has amended certain claims. In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicant respectfully submits that the claim amendments do not limit the range of any permissible equivalents.

Applicant acknowledges the continuing duty of candor and good faith in the disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine

⁴ Applicant makes no statement whether such combination is even proper.

of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and his attorneys.

Applicant respectfully submits that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if it would expedite the prosecution of this application.

Respectfully submitted,

Date: March 24, 2005

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